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60,427-218  
2000P09005US01

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Karell  
Serial No.: 09/844,938  
Filed: 04/27/2001  
Group Art Unit: 2833  
Examiner: Ta, Tho Dac  
Title: ELECTRIC CONNECTION FOR FUEL INJECTORS

**RESPONSE**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper is responsive to the Office Action mailed on May 10, 2004.

Applicant respectfully traverses the rejection under 35 U.S.C. §103 relying upon the improper combination of the *Romann, et al.* reference with the *Murakami* reference. The combination cannot be made.

It is axiomatic that there must be some motivation to combine references in an attempt to establish a *prima facie* case of obviousness. Where there is no benefit to making a combination, there is no motivation and no *prima facie* case of obviousness.

In this instance, there is no benefit to adding the teachings of *Murakami* to the *Romann, et al.* arrangement. As previously discussed, the *Romann, et al.* arrangement includes conductors 5 associated with openings 8 in a printed circuit board. Electrical connections between pins 9 and the conductors 5 are made by receiving the pins through

the openings 8. Then soldering, welding or "solderless squeezing" completes the permanent electrical connection.

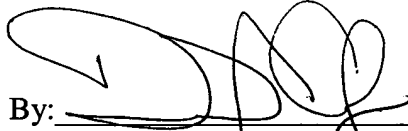
There is no benefit to adding the teachings of *Murakami* because the *Romann, et al.* reference already discloses a complete way of making connections. The addition of *Murakami's* teachings would be redundant, at best.

There is no suggestion within the art for making the combination and hindsight reasoning using Applicant's disclosure and claims as a road map for piecing together the prior art is not permissible.

This case has been in condition for allowance for some time. Applicant respectfully requests a Notice of Allowance as soon as possible.

Respectfully submitted,

CARLSON, GASKEY & OLDS

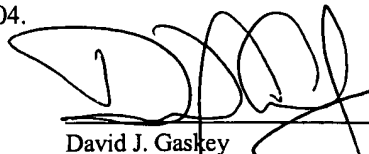
By: 

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Dated: August 10, 2004

**CERTIFICATE OF MAILING**

I hereby certify that the enclosed Response is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on August 10, 2004.

  
David J. Gaskey

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